PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional)
NEO1P026A

First named inventor: Gough

Application No.: 09/997,322

Art Unit: 2177

Filed: 11/27/2001

Examiner: Pham

Title: METHOD AND APPARATUS FOR THE PRODUCTION, DELIVERY AND RECEIPT OF AUDIOVISUAL E-MAIL (AS AMENDED)

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (703) 872-9306

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The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
    (1) Petition fee;
    (2) Reply and/or issue fee;
    (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
    (4) Statement that the entire delay was unintentional.

1. Petition fee
    [✓] Small entity-fee $ 750_____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

    [ ] Other than small entity – fee $ _____ (37 CFR 1.17(m))

2. Reply and/or fee
    A. The reply and/or fee to the above-noted Office action in the form of Amendment B _____(identify type of reply):

        [ ] has been filed previously on _____.
        [✓] is enclosed herewith.

    B. The issue fee and publication fee (if applicable) of $ _____.
        [ ] has been paid previously on _____.
        [ ] is enclosed herewith.

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PTO/SB/64 (09-04)
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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

[✓] Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

[ ] A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

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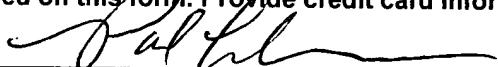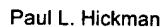
_____	_05-28-05_
Signature	Date
Paul L. Hickman	28,516
Typed or printed name	Registration Number, if applicable
P.O. Box 1823	650-333-0180
Address	Telephone Number
Los Altos, CA 94023	
Address	

Enclosures: [ ] Fee Payment

[✓] Reply

[ ] Terminal Disclaimer Form

[ ] Additional sheets containing statements establishing unintentional delay

[ ] Other:_____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

[✓] Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

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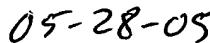
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Date

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Signature

Paul L. Hickman
Typed or printed name of person signing certificate

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: GOUGH ET AL.

APPLICATION NO.: 09/997,322

FILED: November 27, 2001

FOR: METHOD AND APPARATUS FOR THE PRODUCTION, DELIVERY, AND RECEIPT OF AUDIOVISUAL E-MAIL (AS AMENDED)

EXAMINER: Pham, K.

ART UNIT: 2177

CONF. NO: 3459

Amendment B

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia
22313-1450

Sir:

This Amendment B is in response to an Office Action dated 08/25/04. A Petition to Revive due to Unintentional Delay is enclosed herewith. Please enter the amendments and consider the remarks that follow.

In the Claims

Please amend the claims as follows:

1.   (previously presented)   A method for providing an audiovisual e-mail system comprising:

providing a server connected to a network;

inputting a message and an audiovisual enhancement which is associated with said message from a sender into said server, said message to be sent as an e-mail to at least one recipient on said network;

associating said message with a self-executing programmable enhancement operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message; and

sending said e-mail over said network to said at least one recipient.

33.   (previously presented)   A method as recited in claim 1 wherein said audiovisual enhancement includes both audio and visual components.

34.   (previously presented)   A method as recited in claim 1 wherein said audiovisual enhancement includes only an audio component.

35.   (previously presented)   A method as recited in claim 1 wherein said audiovisual enhancement includes only a visual component.

36.   (previously presented) A method as recited in claim 1 wherein said audiovisual enhancement includes a streaming video displayed within a window of a recipient's machine.

37.   (currently amended) A method as recited in claim 1 wherein said ~~video~~ <u>audiovisual enhancement</u> is developed on a sender's machine, and is transmitted to said server over said network.

38.   (previously presented) A method as recited in claim 37 wherein said network includes a TCP/IP network.

39.   (previously presented) A method as recited in claim 38 wherein said network includes the Internet.

40.   (currently amended) Computer program segments embodied in computer readable media to provide an audiovisual e-mail system comprising:

a code segment transmitting over a network to a server an audiovisual enhancement which is associated with a message from a sender, said message to be sent as an e-mail to at least one recipient on said network; and

a code segment associating said ~~said~~ message with a self-executing code segment operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message upon the selection of said message by said at least one recipient.

41. (previously presented) Computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein said audiovisual enhancement includes both audio and visual components.

42. (previously presented) Computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein said audiovisual enhancement includes only an audio component.

43. (previously presented) Computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein said audiovisual enhancement includes only a visual component.

44. (previously presented) Computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein said audiovisual enhancement includes a streaming video displayed within a window of said recipient's machine.

45. (previously presented) Computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein said audiovisual enhancement is developed on a sender's machine.

46. (previously presented) An audiovisual e-mail system comprising:

means transmitting over a network to a server from a sender machine an audiovisual enhancement which is associated with a message from said sender, said message to be sent as an e-mail to at least one recipient on said network; and

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means associating said ~~said~~ message with a self-executing program operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message on a recipient machine upon the selection of said message by said at least one recipient.

47.   (previously presented) An audiovisual e-mail system as recited in claim 46 wherein said audiovisual enhancement includes both audio and visual components.

48.   (previously presented) An audiovisual e-mail system as recited in claim 46 wherein said audiovisual enhancement includes only an audio component.

49.   (previously presented) An audiovisual e-mail system as recited in claim 46 wherein said audiovisual enhancement includes only a visual component.

50.   (previously presented) An audiovisual e-mail system as recited in claim 46 wherein said audiovisual enhancement includes a streaming video displayed within a window of said recipient's machine.

51.   (previously presented) An audiovisual e-mail system as recited in claim 46 wherein said audiovisual enhancement is developed on said sender's machine.

R E M A R K S

Claims 1 and 33-51 are currently pending in this application.

The Examiner is thanked for his courteous telephone call in late March, 2005 inquiring as to whether there had been a response to his Office Action dated 08/25/04. A review of Applicant's file provided no evidence of having received this Office Action, nor any Notice of Abandonment. The apparent abandonment of this application was unintentional. The Examiner is further thanked for the courtesy copy of the Office Action received in part on 3/23/05 and received in another part on 3/29/05 to provide the basis for this response and for the revival of the application.

Claim Objections

Claims 40-51 were objected to because of the duplicated word "said" in claims 40 and 46. Applicant thanks the Examiner for pointing out this error, and has removed the duplicative word. The amendments of claims 40 and 46 are made clearly to correct clerical errors, and are not limiting in nature nor introduced for the purpose of patentability. Applicant respectfully requests that the objections to claims 40-51 be withdrawn.

Claim Rejections Under 35 U.S.C. §112, ¶2

Claim 37 was rejected under 35 U.S.C. §112, ¶2 as being indefinite for lack of antecedent basis. Claim 37 has been amended to change "video" to -- audiovisual enhancement --. This is not a narrowing amendment but, rather, and amendment to correct an obvious clerical error. Applicant respectfully requests that the rejection of claim 37 be withdrawn.

Claim Rejections under 35 U.S.C. §102(e)

Claims 1 and 33-51 were rejected under 35 U.S.C. §102(e) as being anticipated by Budge et al., U.S. Patent No. 6,014,689 (hereafter "Budge"). Applicant respectfully traverses, as set forth below.

The Budge Reference

Budge describes a system wherein video messages are created in a manner that allows delivery over an electronic mail (e-mail) system. The audio and video components of the message are recorded, encoded, and synchronously combined into a video message file. A player is selectively attached to the video message file to create an executable file which can be <u>delivered as a standard binary file</u> over conventional communications networks. To view the received video e-mail, <u>the recipient executes the received file</u> and the attached player automatically plays the video and audio message or the recipient executes the previously installed player which plays the video message.

The Budge Reference Distinguished

The Budge reference describes a system that is markedly different from Applicant's claimed embodiments. With Applicant's embodiments, an e-mail message is combined with a *self-executing* programmable enhancement which is *streamed* over a network to display the audiovisual enhancement *in conjunction with the message*. Budge, in marked contrast, merely <u>attaches</u> an audiovisual file to an e-mail. As such, it is neither associated with the message, nor streamed over the network. Furthermore, while Budge optionally allows for the bundling of a video and audio player with a multimedia data file, such a file is not "self-executing." That is, the file would have to be <u>downloaded as an attachment</u> and then <u>activated</u> to cause execution.[1]

The Budge reference clearly describes the e-mail attachment as a "file." For example, <u>Budge refers to the e-mail attachment as a file in many places</u>. For example:

> "The system provides means for capturing a video image and an audio signal. The video image and audio signal are encoded and combined into a multimedia data file. Selectively attached to this data file is an executable video e-mail player. The video e-mail system provides a means for transferring this multimedia data file to an e-mail client for eventual transfer to an e-mail recipient." Budge, Col. 2, lines 22-27;

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[1] *See*, for example, Budge Abstract, "the recipient executes the received file"

"A video message is generated at a sending location and a file is created from the video message. An executable player is attached to the file, which is sent over a communications link to a receiving location. The player is executed at the receiving location to retrieve the video message from the file." Budge, Col. 2, lines 29-34; and

"The player retrieves the video message, or clip, 420 from this video file." Budge, Col. 5, lines 7-8

Budge only discloses the creation and transmission of a multimedia file for playing at a recipient's computer. This file must be activated by the recipient and executed at the recipient's computer. This can clearly be seen in Figs. 3 and 4 of Budge:
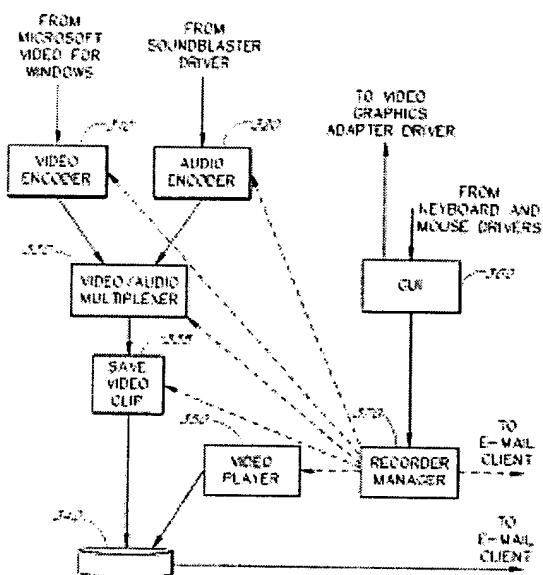

FIG. 3
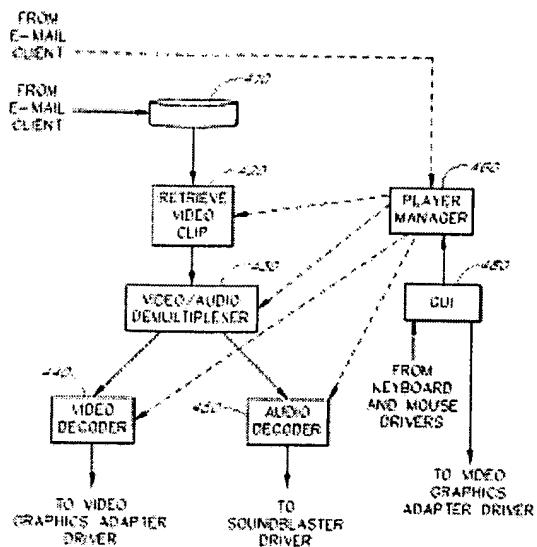
FIG. 4

As seen in Fig. 3 (the sender's side), the file is saved in an operation 335 to a hard disk 340. It is then sent to the sender's e-mail client for eventual transmission by being attached to an e-mail. This is referred to as the "recorder" in Budge. As seen Fig. 4 (the recipient's side), the file is retrieved from a recipient's e-mail client, and stored on a hard disk 410 for decoding and playing. This is referred to as the "player" in Budge. It should be noted that at no time is the multimedia files *associated* with the message as claimed by applicant: it merely is a passenger riding on the e-mail transmission.

It is also abundantly clear from the above discussion that the audiovisual file of Budge is not streamed from a server to a recipient. It is stored firstly in a hard disk 340 on the sender side, and then stored secondly in a hard disk 410 on the recipient side. It is never *streamed* over a network from a server to a recipient, as claimed by Applicant.

The Examiner cited Col. 5, lines 4-17 of Budge as indicating that he streams multimedia from a server. Applicant respectfully traverses. This paragraph is reproduced below:

FIG. 4 shows a block diagram of a preferred embodiment of the video e-mail player 220. The player reads a video e-mail file 410, originating from the resident Email client. The player retrieves the video message, or clip, 420 from this video file. The player has a demultiplexer 430 which separates the video and audio data from the video file. The video data is decoded and typically decompressed with a video decoder 440 which transfers the video data to the video driver. The audio data is decoded and typically decompressed with an audio decoder 450 which transfers the audio data to the sound card driver. The various player functions are directed by the player manager 460. A graphical user interface (GUI) 480 provides for user control of the player functions. **Budge, Col. 4-17**

Applicant fails to see <u>any</u> support for streaming in this paragraph. Each and every operation in this paragraph (see Fig. 4, above) is performed at the recipient's computer. There is <u>no</u> indication that there is any streaming from a server taking place but, rather, the multimedia file is being processed on the recipient's computer.

It is also clear that Budge does not associate the multimedia file with the message. Instead, a separate multimedia player window is caused to pop-up, with VCR-like controls. See Fig. 6 of Budge, below:
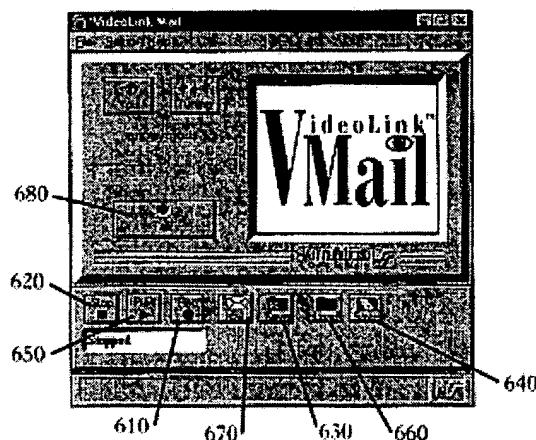

FIG. 6

This multimedia player is not *associated* with a message, as claimed by Applicant. See Applicant's Fig. 12, reproduced below.
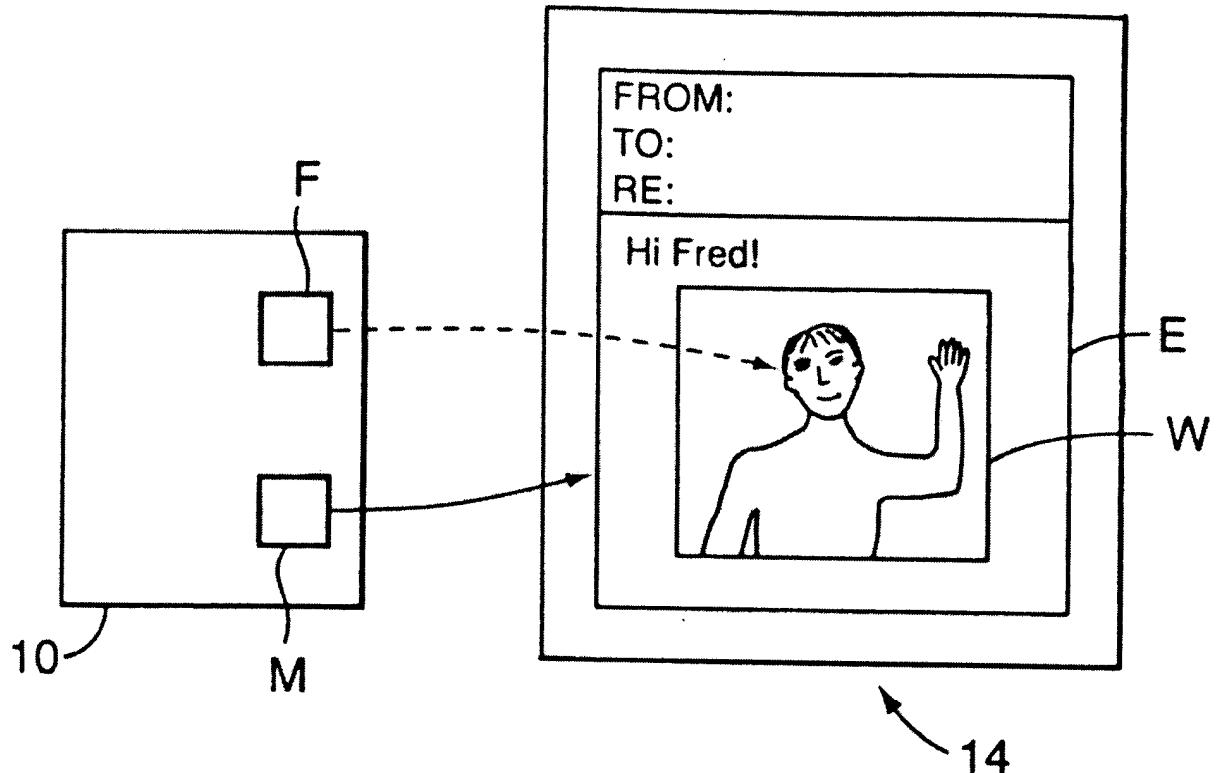
FIG. 12

As seen in Applicant's Fig. 12, the audiovisual content (the man smiling and waving) is *associated* with the message "Hi Fred!" The audiovisual content can be stored on a server 10 as a file F, and streamed into the e-mail message E as indicated by the broken line arrow.

Each of the independent claims 1, 40 and 46 therefore include one or more limitations that are simply not found in or suggested by Budge. Budge teaches the attachment of an audiovisual file to an e-mail, where the playing of the file is fully on the recipient's machine, while Applicant claims the *association* of an audiovisual enhancement with a message in an e-mail, where the audiovisual enhancement is *self-executing* and is *streamed* over a network to the recipient's computer from a server.

Claims 1, 40 and 46 are clearly patentable over Budge, and the rejections of these independent claims are respectfully requested to be withdrawn.

The dependent claims are patentable for at least the same reasons as set forth above with respect to the independent claims. Applicant therefore respectfully request that the rejections of the dependent claims be withdrawn as well.

Conclusion

All claims being patentable, the Examiner respectfully requested to provide Applicant with an early Notice of Allowance. If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 838-4443.

Respectfully submitted,

Date: 05-28-05

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